

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-101 were pending in the present patent application. By way of this reply, claims 5, 9, 11-18, 20-25, 27-32, 34, 35, 37, 40-44, 47-64, 67-70, 72-86, and 89-101 have been cancelled without prejudice or disclaimer. Claims 1, 66, 71, and 87 are independent. The remaining claims depend, either directly or indirectly, on claims 1 and 87.

Claim Amendments

Claims 19 and 45 have been amended for clarification. Claim 33 has been amended to include the limitations of now-cancelled dependent claim 34. Claim 39 has been amended to include the limitations of now-cancelled dependent claim 40.

IDS

Applicant asserts sheet 2 of the Information Disclosure Citation filed on August 22, 2000 has not been fully considered by the Examiner. The Examiner has not initialed references C1, C2, and C3. Applicant has enclosed a copy of this sheet and respectfully requests the Examiner acknowledge and consider these three references.

Drawings

Applicant respectfully requests the Examiner acknowledge the formal drawings filed on January 19, 2000 and indicate whether they are acceptable.

Rejections under 35 U.S.C. 103

Claims 1-7, 66, and 68-70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,823,264 issued to Deming (hereinafter “Deming”), in view of U.S. Patent No. 6,173,272 issued to Thomas (hereinafter “Thomas”), and publication “From electronic money to electronic cash: payment on the Net” authored by Buck (hereinafter “Peter”). By way of this reply, claims 5 and 68-70 have been cancelled and thus the rejection is moot as to those claims. As for the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See MPEP §706.02(j) and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present invention is directed towards overcoming the limitations of conventional electronic funds transfer mechanisms (*e.g.*, those which issue paper checks) by providing a low cost, fast, and almost ubiquitously available mechanism for electronically transferring funds using a combination of the Internet and an automated clearinghouse (ACH) system. (*See* Specification at page 5). Independent claim 1 recites, in part, “A computer implemented method of electronically transferring funds from a sender to a receiver... without receiving from the sender a designation of a target account of the receiver...” The Examiner has attempted to equate this limitation with the

non-available RTN scenario disclosed by Deming. (See Office Action dated October 3, 2005 at page 3). This association is improper as Deming discloses an electronic funds transfer system in which the payor (*i.e.*, “sender”) is required to supply the payee’s (*i.e.*, “receiver”) routing and transfer number (RTN) (*i.e.*, target account). (See Deming at column 2, lines 45-61). If the RTN is not available, Deming discloses substituting the receiver’s RTN with the RTN of a credit printing facility to generate a paper check for mailing to the payee. (See Deming at column 3, lines 63-66). Thus, Deming clearly teaches away from the claimed invention. Accordingly, Applicant asserts that the claimed invention as recited in independent claim 1 would not be obvious in view of Deming. Further, Applicant asserts Thomas and Peter do not cure the fact that Deming teaches away from the claimed invention.

Independent claim 1 also recites, in part, “receiving from the sender... contact information of the receiver sufficient for contacting the receiver... the host system receiving from the receiver the designation of the target account for receiving the funds from the sender... wherein the receiver is not required to have previously established ACH originator relationship with an ACH member at which the receiver’s target account is maintained.” As discussed above, Deming discloses an electronic funds transfer system. In Deming’s system, the transfer of funds to a receiver is accomplished, in part, by the sender providing the receiver’s account information (RTN) and then the system using the RTN and the Automated Clearing House (ACH) to credit the receiver’s account. (See Deming at column 2, line 45 to column 3, line 30). Thus, in Deming’s system, the receiver is not contacted to obtain target account information because such information is provided by the sender. Thus, Deming’s system squarely contradicts independent claim 1. Deming does not and cannot teach or suggest each and every limitation of independent claim 1.

Thompson discloses a funds transfer system which uses an intermediate trusted third party (TTP). The TTP is configured to receive a universal identifier number (UID) from the sender identifying the receiver. The TTP uses a central database and the UID to lookup the routing/transit number of the receiver's bank and the receiver's account number (*i.e.*, target account) in order to transfer funds. (*See Thompson at Abstract*). As is the case with Deming, Thompson does not contemplate contacting the receiver to obtain the target account information as recited in the claims. In fact, Thompson requires the receiver account information be already known (*i.e.*, available in the central database) prior to the sender using the system. Thus, Thompson, like Deming, squarely contradicts independent claim 1. Further, Thompson does not teach or suggest what Deming lacks.

Peter discloses numerous payment mechanisms for commerce on the Internet. However, none of these payment mechanisms require the sender first provide the receiver's contact information so the receiver may then be contacted to obtain target account information as recited in independent claim 1. Thus, Peter does not teach or suggest every limitation of independent claim 1. Further, Peter also does not teach what both Deming and Thompson lack.

Independent claim 1 recites, in part, "the host system providing a first instruction to the host financial institution to cause the transfer of funds from the source account to the host account; and the host system providing a second instruction to the host financial institution to cause the transfer of funds from the host account to the target account." Independent claim 66 has similar limitations. The host system operates as a third party directly interacting with both sender and receiver. The host system enables funds to be transferred first from the sender's account to the host account, and then from the host account to the intended receiver's account. Both the sender and receiver interact directly with the host system. Neither Peter, Deming, nor Thompson disclose a host system which uses two separate entries in the ACH network to transfer funds first from a

sender account to a third party account, and then from the third party account to the receiver. Applicant acknowledges that during a single ACH transaction, funds may be transferred between numerous points (*i.e.*, third parties) until reaching the final destination. However, as recited in the claims, the host account is a final destination and a second entry in the ACH network is required to move the funds from the host account to the receiver's account.

Further, Applicant acknowledges Thompson discloses a trusted third party (TTP). However, Applicant asserts Thompson's TTP is only used to lookup the account information of the receiver. Thompson's TTP neither accepts nor temporarily holds the funds destined for the receiver, nor does Thompson's TTP interact directly with both the sender and receiver (*i.e.*, interaction is with the sender/receiver's financial institution, not directly with sender/receiver). Thus, Thompson's TTP is not and cannot be the host system as recited in the claims. Deming and Peter do not disclose such a host system and thus do not and cannot teach what Thompson lacks.

Peter, Deming, and Thompson, whether viewed separately or in combination, fail to teach or suggest each and every limitation of independent claims 1 and 66. Thus, independent claims 1 and 66 are patentable over Peter, Deming, and Thompson. Claims 2-4, 6, and 7 depend directly from claim 1 and are allowable for at least the same reasons.

Claims 8-55, 57-65, 71-83, and 85-101 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Deming, in view of Thomas, Peter and U.S. Patent No. 5,903,881 issued to Schrader et al (hereinafter "Schrader"). By way of this reply claims 9, 11-18, 20-25, 27-32, 34, 35, 37, 40-44, 47-64, 67-70, 72-86, and 89-101 have been cancelled and thus the rejection is moot as to those claims. As for the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

As an initial matter, Applicant notes that various combinations of one or more of four references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a “road map” for selecting and combining prior art disclosures is wholly improper. See MPEP 2143.01; *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”).

As discussed above, independent claims 1 and 66 are patentable over Deming, Thomas, and Peter. Schrader discloses a user interface that integrates the various tasks separately associated with personal finance software products and with online banking products. (See Schrader at Abstract). However, like Deming, Thomas, and Peter, Schrader is silent regarding the host system as discussed above and recited in the claims. Thus, Schrader does not teach or suggest what Deming, Thomas, and Peter lack. Thus, claims 1 and 66 are patentable over Deming, Thomas,

Peter, and Schrader. Claims 8, 10, 19, 26, 33, 36, 38, 39, 45, 46, and 65 depend, either directly or indirectly, from claim 1 and are patentable for at least the same reason.

The Examiner asserts independent claim 71 is rejected under the same rationale as claims 1 and 66. (*See* Office Action dated October 3, 2005 at page 7). As discussed above, independent claims 1 and 66 are patentable over Deming, Thomas, Peter, and Schrader. Thus, Applicant asserts independent claim 71 is also patentable over Deming, Thomas, Peter, and Schrader for at least the same reasons.

The Examiner asserts independent claim 86 is rejected under the same rationale as claims 1 and 66. (*See* Office Action dated October 3, 2005 at page 8). As discussed above, independent claims 1 and 66 are patentable over Deming, Thomas, Peter, and Schrader. Thus, Applicant asserts independent claim 86 is also patentable over Deming, Thomas, Peter, and Schrader. Claim 87 depends directly on claim 86 and is allowable for at least the same reasons.

Deming, Thomas, Peter, and Schrader fail to teach or suggest each and every limitation of independent claims 1, 66, 71, and 86. Thus, independent claims 1, 66, 71, and 86 are patentable over Deming, Thomas, Peter, and Schrader. Claims 8, 10, 19, 26, 33, 36, 38, 39, 45, 46, 65, and 87 depend, either directly or indirectly, on claims 1 and 86 and are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed

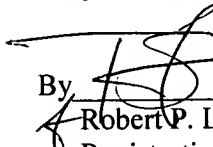
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Respectfully submitted,

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